

## **REMARKS**

### **I. Status of Claims**

Claims 1-63 are currently pending. Claims 26, 27, and 30 are amended herein to correct minor informalities. Similar amendments are made in the specification.

Applicants have not introduced any new matter by the amendment, nor does the amendment raise new issues or necessitate the undertaking of any additional search of the art by the Office.

### **II. Obviousness-Type Double Patenting Rejections**

Claims 1-63 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,565,862 to Bara and also as being unpatentable over claims 1-63 of U.S. Patent No. 6,689,345 to Jager Lezer. Office Action, pages 2-6. Claims 1-16, 32-60, 62, and 63 are additionally rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,403,704 to Bara and unpatentable over claims 1-42 of U.S. Patent No. 7,094,842 to Lennon. *See id.* at 6-8.

#### **U.S. Patent No. 6,403,704**

Claims 1-16, 32-60, 62, and 63 are rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-18 of U.S. Patent No. 6,403,704 to Bara ("the '704 patent"). *Id.* at 6-8. Since, however, the '704 patent has expired due to non-payment of the maintenance fee, the double patenting rejection over the '704 patent is moot and should be withdrawn.

U.S. Patent No. 6,565,862

Claims 1-63 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-26 of U.S. Patent No. 6,565,862 to Bara ("the '862 patent"). *Id.* at 2-4. Applicants respectfully traverse this rejection for at least the following reasons.

According to MPEP § 804 II.B.1., an obviousness-type double patenting rejection employs similar guidelines to those used for a statutory obviousness rejection under 35 U.S.C. § 103, except that only the claims themselves are analyzed and the disclosure of the cited patent or application may not be used as the basis of the rejection. Because the '862 patent was filed before the instant application was filed, the "one-way" test of obviousness is used to determine "whether the invention defined in a claim in the application is an obvious variation of the invention defined in a claim" in the '862 patent. *See* MPEP § 804 II.B.1.(a) (*citing In re Berg*, 46 U.S.P.Q.2d 1226 (Fed. Cir. 1998)). The proper application of this test, in light of the established general principles for obviousness, reveals that claims 1-63 of this application are not obvious over claims 1-26 of the '862 patent.

Specifically, under the one-way test for obviousness of *Berg*, to make a proper obviousness-type double patenting rejection, the Office must show that the presently claimed invention is an obvious variation of the invention claimed in the '862 patent. To establish a *prima facie* case of obviousness, the Office must show that the claims of the '862 patent teach or suggest all of the limitations of the rejected claims and that there is some reason why one of ordinary skill in the art would have been led to modify the prior

art to arrive at the presently claimed invention. See MPEP §§ 2143 and 804 II.B.1.

Applicants assert that the Office has failed to satisfy these requirements here.

Claim 1 of the '862 patent recites a cosmetic composition comprising a particulate phase and an aqueous phase comprising particles of an at least partially crosslinked elastomeric solid organopolysiloxane. The Examiner concedes that the claims of the '862 patent "do not recite the exact ratios of the instant claims," but alleges that "it would have been obvious for one of an ordinary skill in the art at the time of the instant invention to optimize the amounts or ratios of the individual components of the composition of the patented claims because the patented composition is used to prepare the same cosmetic products that are also claimed in the instant application."

Office Action, page 3. Applicants respectfully disagree.

As the Examiner admits, the claims of the '862 patent do not teach or suggest all of the limitations of the rejected claims, specifically, the ratios recited in the rejected claims.

In addition, the Examiner has failed to point to anything in the claims of the '862 patent that would have led a skilled artisan to modify the composition claimed therein so as to arrive at the presently claimed invention. The present invention relates to compositions having a pasty or pulverulent texture, which is imparted by the claimed ratio of organopolysiloxane to particulate phase. However, none of the claims in the '862 patent provide any reason to pick and choose the particular claimed ratio of ratio of organopolysiloxane to particulate phase to achieve the present invention. Thus, it cannot be said that one skilled in the art would have been motivated to "optimize" the compositions of the '862 patent to achieve the present invention, as alleged by the

Examiner. Accordingly, this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

U.S. Patent No. 6,689,345

Claims 1-63 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-63 of U.S. Patent No. 6,689,345 to Jager Lezer ("the '345 patent"). Office Action, pages 4-6. The Examiner similarly concedes that the '345 patent does not teach the ratios of the instant claims, but asserts that it would have been obvious to one skilled in the art to optimize the compositions of the '345 patent to achieve the present invention. *See id.* at 4. Applicants respectfully traverse the rejection for at least the following reasons.

The standard for a proper double-patenting rejection is discussed above. The '345 patent was filed before the present application, thus, the one-way test for obviousness applies. *See supra.*

Claim 1 of the '345 patent is directed to a cosmetic composition comprising a dyestuff and an aqueous phase comprising fibers and particles of an at least partially crosslinked solid elastomer polyorganosiloxane. As the Examiner admits, the claims of the '345 patent do not teach or suggest all of the limitations of the rejected claims, specifically, the ratios recited in the rejected claims.

In addition, the Examiner has failed to provide any reason to modify the claimed composition in the '345 patent to arrive at the presently claimed composition. The present invention relates to compositions having a pasty or pulverulent texture, which is imparted by the claimed ratio of organopolysiloxane to particulate phase. However, none of the claims in the '345 patent provide any reason to pick and choose the

particular claimed ratio of ratio of organopolysiloxane to particulate phase to achieve the present invention. Thus, it cannot be said that one skilled in the art would have been motivated to “optimize” the compositions of the '345 patent to achieve the present invention, as alleged by the Examiner. Accordingly, this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

U.S. Patent No. 7,094,842

Claims 1-16, 32-60, 62, and 63 are rejected on the ground of non-statutory obviousness-type double patenting as being unpatentable over claims 1-42 of U.S. Patent No. 7,094,842 to Lennon (“the ‘842 patent”). Office Action, pages 6-8. The Examiner similarly concedes that the ‘842 patent does not teach the ratios of the instant claims, but asserts that it would have been obvious to one skilled in the art to optimize the compositions of the ‘842 patent to achieve the present invention. *See id.* at 6. Applicants respectfully traverse the rejection for at least the following reasons.

The standard for a proper double-patenting rejection is discussed above. The ‘842 patent was filed before the present application, thus, the one-way test for obviousness applies. *See supra.*

Claim 1 of the ‘842 patent is directed to a composition comprising a dispersion of particles of a substantially linear block silicone copolymer and at least one additional polymer. However, the block silicone copolymers are not elastomers, and should be crosslinked to obtain elastomeric properties.

Further, as the Examiner admits, the claims of the ‘842 patent do not teach or suggest all of the limitations of the rejected claims, specifically, the ratios recited in the rejected claims. Thus, for at least these reasons, this rejection is improper.

In addition, the Examiner has failed to provide any reason why a skilled artisan would modify the claimed composition in the '842 patent to arrive at the presently claimed invention. The present invention relates to compositions having a pasty or pulverulent texture, which is imparted by the claimed ratio of organopolysiloxane to particulate phase. However, none of the claims in the '842 patent provide any reason to pick and choose the particular claimed ratio of ratio of organopolysiloxane to particulate phase to achieve the present invention. Thus, it cannot be said that one skilled in the art would have been motivated to "optimize" the compositions of the '842 patent to achieve the present invention, as alleged by the Examiner. Accordingly, this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

### **III. Rejections Under 35 U.S.C. § 103(a)**

The Examiner rejects claims 1-63 as unpatentable over the '704 patent, the '345 patent, the '862 patent, the '842 patent, or U.S. Patent No. 6,184,277 to Bara ("the '277 patent"). See Office Action, pages 8-11. Claims 1-20, 25-26, and 28-63 are rejected under 35 U.S.C. § 103(a) as unpatentable over U.S. Patent No. 5,928,660 to Kobayashi et al. ("the '660 patent"). See *id.* at 12-13. Claims 21-24 and 27-31 are rejected under 35 U.S.C. § 103(a) as unpatentable over the '660 patent<sup>1</sup> in view of JP 2001199828 ("JP '828"). See *id.* at 13-14. Applicants respectfully traverse these rejections for at least the following reasons.

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<sup>1</sup> The Examiner listed U.S. Patent No. 5,853,711 in the Office Action, page 13. However, based on the remaining text of the rejection on page 13 of the Office Action, Applicants believe that the Examiner meant to refer to the '660 patent. Therefore, Applicants respectfully request clarification of the record.

To establish a *prima facie* case of obviousness, the Office must show that the cited references teach or suggest all of the limitations of the rejected claims and that there is some reason why one of ordinary skill in the art would be led to modify or combine the teachings of the cited references to arrive at the presently claimed invention. See MPEP § 2143. The Supreme Court, in its recent decision in *KSR Int'l Co. v. Teleflex, Inc.*, mandated that "[t]o facilitate review, this analysis [of whether there was an apparent reason to combine the known elements in the fashion claimed by the patent at issue] should be made explicit." *KSR Int'l Co. v. Teleflex, Inc.*, No. 04-1350 (U.S. Apr. 30, 2007), slip op. at 14 (citing *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006) ("[R]ejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness"))).

Following the *KSR* decision, the Office issued a memorandum to its technology center directors on May 3, 2007, indicating that **"in formulating a rejection under 35 U.S.C. § 103(a) based upon a combination of prior art elements, it remains necessary to identify the reason why a person of ordinary skill in the art would have combined the prior art elements in the manner claimed."** (Emphasis in original). Applicants submit that those criteria have not and cannot be met here.

The '704, '862, and '345 patents

As the Examiner admits, none of the '704, '862, and '345 patents teaches or suggests the claimed ratio of organopolysiloxane to particulate phase as recited in, e.g., claim 1. Office Action, pages 9 and 10. Furthermore, the Examiner has not given any

explicit reason why one of ordinary skill in the art would have been motivated to modify the composition of any of the '704, '862, and '345 patents by incorporating therein the organopolysiloxane and particulate phase in amounts sufficient to arrive at the claimed ratio (i.e., ranging from 0.4:1 to 1.8:1 as recited in e.g., claim 1). The present invention relates to compositions having a pasty or pulverulent texture, which is imparted by the claimed ratio of organopolysiloxane to particulate phase. However, none of the '704, '862, and '345 patents teaches or suggests the desirability of a composition having such a pasty or pulverulent texture. Thus, it cannot be said that one skilled in the art would have been motivated to "optimize" the compositions of the '704, '862, or '345 patents by picking and choosing the particular claimed ratio of organopolysiloxane to particulate phase to achieve the present invention, as alleged by the Examiner. Therefore, the rejections over the '704, '862, or '345 patent are improper and Applicants respectfully request these rejections be withdrawn.

U.S. Patent No. 7,094,842

As discussed above, the '842 patent is directed to dispersions of silicone block polymers, which are not elastomers. Silicone block polymers must be crosslinked to obtain elastomeric properties. Thus, for at least this reason, this rejection is improper.

In addition, the '842 patent does not teach or suggest organopolysiloxane particles, much less the particular ratio of organopolysiloxane to particulate phase as recited in, e.g., claim 1. Indeed, the Examiner admits that the '842 patent does not teach or suggest the claimed ratio. Office Action, page 11. Further, the '842 patent nowhere teaches or suggests the desirability of a composition having a pasty or pulverulent texture as discussed above. Thus, it cannot be said that one skilled in the



art would have been motivated to “optimize” the compositions of the ‘842 patent to achieve the present invention, as alleged by the Examiner. Accordingly, this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

U.S. Patent No. 6,184,277

The ‘277 patent does not teach or suggest organopolysiloxane particles suspended in an aqueous phase, as presently claimed. For at least this reason, this rejection is improper.

Moreover, as the Examiner admits, the ‘277 patent nowhere teaches or suggests the claimed ratio of organopolysiloxane to particulate phase as recited in, e.g., claim 1. Office Action, page 11. Because the compositions of the ‘277 patent are oil-based gel compositions (col. 1, lines 20-22), and the ‘277 patent does not disclose an aqueous suspension of organopolysiloxane particles, one skilled in the art would not have been motivated to modify the composition of the ‘277 patent by incorporating into it such an aqueous suspension, much less in the amounts specified by the presently pending claims. Therefore, this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

U.S. Patent No. 5,928,660

As the Examiner admits, the ‘660 patent fails to teach the claimed ratios and amounts of organopolysiloxane, particulate powders, waxes, and gelling agents, etc. Office Action, page 12. However, the Examiner asserts that “optimizing the amounts or ratios of the particulate powders [and] silicone rubber with an expectation to achieve a stable composition would have been within the scope of a skilled artisan.” *Id.* at 12-13. Applicants respectfully disagree.

The '660 patent discloses cosmetic compositions comprising a cosmetic raw material consisting of an aqueous suspension of a powdered silicone rubber with a mean particle size of 0.1 to 500 microns. See abstract. The cosmetic raw material is produced by mixing a silicone rubber with a fine inorganic powder, so as to coat the surface of the silicone. See col. 4, line 65 – col. 5, line 5. The inorganic powder is added in an amount ranging from 0.1 to 50 parts per 100 parts by weight of powdered silicone rubber, i.e., an amount sufficient to cover the surface of the silicone particles. See col. 5, lines 28-41. Thus, the cosmetic compositions of the '660 patent comprise an aqueous suspension of coated silicone rubber particles, not an aqueous suspension of silicone rubber particles and an inorganic particulate phase as suggested by the Examiner. As such, the amount of inorganic powder used in the '660 patent does not correlate to the presently claimed particulate phase, and is irrelevant.

The Examiner additionally points to column 6, lines 10-65 of the '660 patent, which provides a lengthy laundry list of optional ingredients to be included in the cosmetic composition and asserts that pigments, fatty materials, waxes, and thickeners are listed among the various optional additives. Office Action, page 12. However, Applicants submit that the mere presence of a particular ingredient in a laundry list of optional ingredients cannot serve as an “explicit reason” for the skilled artisan to select, among myriad choices, and to specifically include particulate matter such as pigments in the compositions of the '660 patent. Moreover, even if the skilled artisan did include particulate matter such as pigments, the '660 patent provides absolutely no disclosure or suggestion of a composition comprising a particulate phase, much less any particular ratios of silicone particles to such a particulate phase as recited in, e.g., claim 1. Thus,

this rejection is improper and Applicants respectfully request that this rejection be withdrawn.

U.S. Patent No. 5,928,660 in combination with JP 2001199828

The '660 patent is discussed above. With respect to claims 21-24 and 27-31, the Examiner concedes that the '660 patent fails to teach the claimed pearlescent and coated particulate materials and relies on JP '828 to provide this element of the claims. Office Action, page 13. As discussed above, the '660 patent alone fails to teach or suggest a cosmetic composition comprising at least one particulate phase, and at least one binder comprising water and particles of at least one partially or completely crosslinked elastomeric solid organopolysiloxane, wherein the ratio of organopolysiloxane to the particulate phase ranges from 0.4:1 to 1.8:1, as presently claimed. JP '828 is relied on by the Examiner solely for the teaching of pearlescent and coated particulate materials. Moreover, JP '828 provides no insight or direction as to the amount of particulate phase and organopolysiloxane in the cosmetic composition. Thus, JP '828 fails to remedy the deficiencies of the '660 patent with respect to the presently pending claims. As such, Applicants assert that this rejection is legally insufficient and request that it be withdrawn.

**IV. Rejection Under 35 U.S.C. § 112**

Claims 27-30 are rejected under 35 U.S.C. § 112, second paragraph, as allegedly indefinite for reciting the trademark Nylon<sup>®</sup>. Office Action, page 14.

Claims 26, 27, and 30 are amended herein to remove the trademark symbol from the generic term "nylon." The specification has also been amended accordingly. As

such, Applicants assert that this rejection has been obviated and respectfully request that it be withdrawn.

**V. Conclusion**

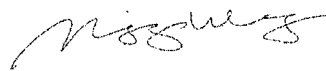
In view of the foregoing, Applicants respectfully request reconsideration of this application and timely allowance of the pending claims. Applicants' undersigned representative invites the Examiner to contact her at 202-408-4218, if a telephone interview would advance prosecution of this case.

If there is any fee due in connection with the filing of this Amendment and Reply, please charge the fee to our Deposit Account No. 06-0916.

Respectfully submitted,

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By:   
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